

Official



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Gerard CAILLE, et al. Docket No. Q57408  
Appln. No. 09/462,415 Group Art Unit 2685  
Confirmation No. 5068 Examiner Naghmeh MEHRPOUR  
Filed January 10, 2000  
For: MICROWAVE CIRCUIT WITH PLANAR FILTER

#12  
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4-15-03

**REQUEST TO STRIKE ADVISORY ACTION**

and

**REQUEST FOR ENTRY OF AMENDMENT**

and

**REQUEST FOR EXAMINATION OF AMENDED CLAIMS**

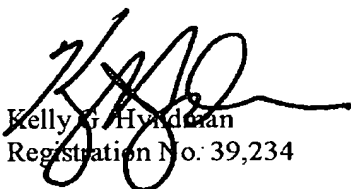
Commissioner for Patents  
Washington, D.C. 20231

Sir:

In the above-identified application, a non-final Office Action was mailed by the USPTO on December 4, 2002. Applicant duly filed a response under 37 C.F.R. § 1.111 on January 30, 2003.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence of 4 pages, including this page and a 1-page exhibit, is being facsimile transmitted to the Patent and Trademark Office Fax No. 703-872-9314 on April 9, 2003.

  
Kelly G. Hyndman  
Registration No. 39,234

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On February 26, 2003, an Advisory Action was mailed by the USPTO indicating that the claim amendments included in the response under 37 C.F.R. § 1.111 filed on January 30, 2003, would not be entered because they raised new issues requiring further consideration or search.

It is respectfully submitted that:

- The Office Action of December 4, 2002, was not a final action because it does not say anywhere that it is final; to the contrary, the Office Action Summary sheet plainly indicates that the action was a non-final action (see attached exhibit).
- Since the Office Action of December 4, 2002, was not a final action, Applicant was permitted in the ensuing response under 37 C.F.R. § 1.111 to amend the claims as of right, and did amend the claims in that response ("these claim amendments," hereafter).
- Since Applicant was permitted under the rules to amend the claims as of right, no authority under 35 U.S.C. or 37 C.F.R. enabled the Examiner to deny entry of these claim amendments.
- Since the Examiner did not have authority to deny entry of these claim amendments, the Advisory Action purporting to deny entry of these claim amendments was improper.
- The issuance of the Advisory Action was not only unauthorized and improper, it was an act inconsistent with the procedural rules of the USPTO, inconsistent with the Federal Rules, and inconsistent with the United States Code -- in short, the issuance of the Advisory Action was an arbitrary and capricious act.
- The Administrative Procedures Act makes it clear that administrative agencies such as the USPTO are not permitted to act in an arbitrary and capricious manner.
- Because the USPTO is not permitted to act in an arbitrary and capricious manner, and because the issuance of the Advisory Action was an arbitrary and capricious act, Applicant respectfully requests that: (1) the Advisory Action be withdrawn,

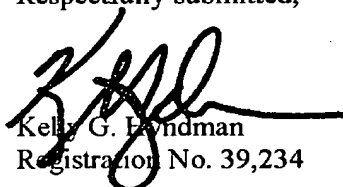
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made of no effect, stricken from the record, or otherwise nullified; (2) the Amendment filed on January 30, 2003, be entered; and (3) the claims as thus amended be fully examined for patentability.

If it is determined that the foregoing request must be made by way of a Petition, Applicant respectfully requests and urges the USPTO to *accept the present paper as such a Petition*, and to charge any necessary petition fee, extension fee, or any other fee required to maintain the pendency of the application with the exception of the issue fee, to our Deposit Account 19-4880.

Applicant further urges the USPTO to refund any necessary petition fee and any extension fee to Applicant because it was an error on the part of the USPTO that made this request necessary, and because Applicant's response to the non-final Office Action within the shortened statutory period avoided the need for any extension of time.

Respectfully submitted,

  
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WASHINGTON OFFICE



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PATENT TRADEMARK OFFICE

Date: April 9, 2003

ENCLOSURE: Exhibit (copy of Office Action Summary)

Exhibit in 09/462,415 -

<b>Office Action Summary</b>	Application No. <b>09/462,415</b>	Applicant(s) <b>Caille et al.</b>
	Examiner <b>Naghmeh Mehrpour</b>	Art Unit <b>2685</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**  
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.  
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).  
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**  
1) ☒ Responsive to communication(s) filed on Sep 23, 2002  
2a) ☐ This action is FINAL.      2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**  
4) ☒ Claim(s) 1-19 is/are pending in the application.  
4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-19 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**  
9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.  
12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**  
13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.  
14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.  
15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**  
1) ☒ Notice of References Cited (PTO-892)      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) ☐ Notice of Informal Patent Application (PTO-152)  
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_      6) ☐ Other: